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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

4740-223

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Application Number

10/672,233

Filed

25 September 2003

First Named Inventor

Julka

Art Unit

2617

Examiner

Casca

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

/Michael D. Murphy/

Signature

☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

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13 July 2010

Date

Registration number if acting under 37 CFR 1.34 _____

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below*.

☒ *Total of 1 forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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In re Application of
Julka, et al.

Claim 25 is directed to a method of managing dormant handoffs of mobile stations at a Packet Data Serving Node (PDSN). In particular, claim 25 stipulates that a PDSN receives a registration request for a first packet data service instance of a mobile station that is undergoing dormant handoff, and, in response to determining that the mobile station has more than one packet data service instance associated with it, the PDSN includes an indication of multiple packet data service instances in the registration reply message sent by it.

In the second paragraph on p. 13 of the Final Action, the examiner concedes that Wang does not teach sending the claimed indication of multiple packet data service instances in the PDSN's registration reply message. However, the rejection arguments on p. 13 go on to state that Wang teaches a source PDSN (S-PDSN) informing a target PDSN (T-PDSN) about a service instance (SI) of a mobile being handed off, and thus says it would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to modify Wang to arrive at the invention of claim 25.

The rejection arguments variously refer to cols. 3 and 4 in Wang, which are explicitly explained in the context of at least one active service instance and not for dormant handoff, and which, in any case, say nothing about the claim limitations at issue. Further references to col. 8 of Wang (the so-called "fifth" embodiment) relate to a scenario where the primary service instance is dormant and other service instances are active. At line 58 in col. 8, Wang states that a mobile's multiple service instances are handed off by sending a handoff command to the mobile. Nothing in that section or elsewhere in Wang teaches or suggests the advantageous PDSN messaging at issue in claim 25.

Thus, the rejection arguments are conclusory and unsupported. Nothing in Wang or the other evidence of record teaches or suggests embedding an indication of multiple packet data service instances in the registration reply message sent from a PDSN, in response to receiving a registration request for a first packet data service instance of a mobile station undergoing dormant handoff. As the Supreme Court noted in its precedential *KSR* decision, the (obviousness) analysis should be made explicit and, more critically, the Court stated that obviousness rejections cannot be sustained by mere conclusory statements and, instead, there must be some articulated reasoning supported by some rational underpinning, to support the legal conclusion of obviousness. *KSR Int'l. Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007) (citing *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)). Here, the examiner does no more than make

vague references to cols. 3 and 4 of Wang, which are explicitly related to active handoff, not the claimed dormant handoff context, and which, in any case, do not teach or suggest the limitations of claim 25.

(b) The combination of Sayeedi and Wang does not render claim 17 obvious.

Claim 17 is directed to aspects of the present invention at a Packet Control Function (PCF), which logically sits between the base stations providing radio service to the mobile stations and the PDSNs providing packet routing to the mobile stations. In the method of claim 17, a PCF recognizes that a mobile station undergoing dormant handoff has multiple packet data service instances associated with it, and, correspondingly, it sends an indication of such to the base station (BS) that is supporting dormant handoff of the mobile station.

As the examiner fully concedes, Sayeedi is silent regarding dormant handoff of multiple packet data service instances. Nonetheless, the rejection arguments assert that the combination of Sayeedi and Wang teaches all of the limitations of claim 17, and that the combination would have been obvious to make. Sayeedi is silent regarding dormant handoff of multiple packet data service instances, and it does not sensibly combine with Wang. Further, because Wang does not teach or suggest a PCF that performs the signaling claimed in claim 17, the obviousness rejection is not legally supported by the cited references.

Put simply, the combination of Sayeedi and Wang can not disclose what is missing in both of them. Neither reference including any teaching or suggestion of the claimed limitation of a PCF sending an indication of multiple packet data service instances to a BS that is supporting dormant handoff of a mobile station. Accordingly, the obvious rejection of claim 17 over Sayeedi in view of Wang fails as a matter of law.

(c) The combination of Sayeedi, Wang, and Lancelot does not render claims 1 and 29 obvious.

Claims 1 and 29 are directed to a base station and a base-station method, wherein the base station initiates dormant handoff of a mobile station that is undergoing a packet data mobility event, in response to receiving a first dormant handoff request from the mobile station for a first packet data service instance of the mobile station. By claiming that the mobile station is dormant, the mobile station by definition does not have a traffic channel assigned to it. Thus, the claims stipulate selectively assigning a traffic channel to the mobile station, in response to recognizing that the mobile station has additional packet data service instances to handoff, to cause the mobile station to send additional dormant handoff requests for those additional packet data service instances over the newly assigned traffic channel.

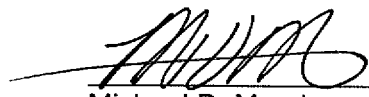
First, Sayeedi expressly teaches that its new “connectionless” signaling is used advantageously in cases where a dormant mobile station undergoing handoff *is not* assigned a traffic channel. (Again, see paragraphs [0016]-[0021] of Sayeedi.) Sayeedi therefore cannot be used as the primary obviousness reference against claims that explicitly teach the selective assignment of a traffic channel.

Second, the attempted combination of Lancelot with Sayeedi has no support in the actual teachings of Sayeedi and Lancelot. At the bottom of p. 4 of the Final Action, the examiner states that Lancelot teaches “recognizing that a mobile station needs a traffic channel over which to send control signals.” In the context of claims 1 and 29, the mobile station does not need a traffic channel—indeed, the prior art handles the claimed scenario using a common channel rather than a traffic channel. At issue in the claims, however, is the advantageous recognition that multiple dormant handoff requests may be more efficiently handled by the network if the mobile station is made to send dormant handoff requests beyond the first one, over a newly assigned traffic channel, rather than over the common channel.

In contrast, Lancelot is directed to cable television systems. Lancelot teaches that a secondary station (such as an individual subscriber unit in a cable system) powers up and registers with a cable control unit (CCU) by obtaining information concerning the location of an access channel, requesting assignment of a traffic channel over that access channel, and then sending a registration message over the subsequently assigned traffic channel. These teachings are unrelated to Sayeedi and do not sensibly combine with Sayeedi, and they are unrelated to the claim limitations at issue.

Finally, in using Sayeedi as the primary reference, the examiner omits key claim language when explaining what Sayeedi teaches. Namely, Item 4 on p. 4 of the Final Action states that Sayeedi teaches **recognizing that a mobile station undergoing dormant (packet data) handoff has a packet data service instance**. The actual claim limitations are receiving a first dormant handoff request for a mobile station, and **recognizing that the mobile station has additional packet data service instances to handoff**. The rejection argument trivializes the claim limitation—i.e., the “recognizing” the examiner attributes to Sayeedi is synonymous with merely receiving a handoff request from a dormant mobile station. That point is reinforced by the fact that Sayeedi says nothing about multiple packet data service instances and says nothing about handing off multiple packet data service instances.

Respectfully submitted,
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